identifying a list of completed data items from a search region within the spreadsheet, said search region including one of (1) cells sharing the same column as the active cell, (2) cells sharing the same row as the active cell, (3) cells within the same column as the active cell and within a range of N cells from the active cell, wherein N is an integer greater than zero, and (4) cells within the same row as the active cell and within a range of N cells from the active cell, wherein N is an integer greater than zero;

defining a partial data entry within the active cell;

identifying a matching completed data item from within said list of completed data items that corresponds to said partial data entry;

displaying said matching completed data item as a suggested completion command for said partial data entry;

receiving an acceptance command in association with said suggested completion; and

in response to said acceptance command, storing said partial data entry with said suggested completion within the active cell.

C2   58.   (Amended) The method of claim 57, wherein said search region is further limited to a range of N cells from the active cell, wherein N is an integer greater than zero.

C3   60.   (Twice Amended) The method of claim 59, wherein said search region is further limited to a range of N cells from the active cell, wherein N is an integer greater than zero.

REMARKS

Claims 1-60 are currently pending in this reissue application, including original claims 1-38 of U.S.P.N. 5,845,300, and new claims 39-60 added by the reissue application. Claims 1-60 were rejected due to two defects in the reissue declaration, one relating to a purported recapture of subject matter that was previously surrendered (i.e., an inappropriate "error" for purposes of reissue), and a second defect regarding a failure to claim that the error arose without deceptive intent. Additionally, it was noted that no offer to surrender the patent was made and

that the assignee had failed to establish its ownership of the subject patent due to the failure to note the frame and reel number of the assignment. Furthermore, newly added claims 39-46, 50-54 and 56-60 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith, Do It Yourself Databases, MacUser, v. 9, n. 11, p. 126(8), 11/93 (hereinafter "Smith"), in view of Novell, Quattro Pro User's Guide, 1994 (hereinafter "Novell), and Sullivan, Intuit's Upgrade Quickens Pace of Personal Finance, MacWeek, v. 7, n. 29, p. 52(2), 7/19/93 (hereinafter "Sullivan").

Offer to Surrender Patent and Consent of Assignee

As noted in the Office action (and also at 37 C.F.R. 1.178(a) and MPEP § 1416), the surrender of the original patent (or the submission of an appropriate statement regarding the loss or inaccessibility of the original patent) need only be supplied prior to allowance of the application. Applicant intends to submit either the original patent or a statement regarding its inaccessibility once the issues in the Office action have been resolved.

Submitted herewith is a substitute consent of the assignee to the reissue application containing the frame and reel number of the originally recorded assignment as requested by the Examiner.

Alleged Defects in the Reissue Declaration

The Office action notes two defects in the declaration: (1) the error relied on to support reissue is not an error upon which reissue can be based due to recapture; and (2) the declaration by the inventors does not include the statement "all errors being corrected in the reissue application up to the time of the filing of the oath or declaration arose without deceptive intent."

With respect to the first alleged error, Applicant respectfully traverses this error for the reasons detailed in the following section relating to recapture. That is, the reissue claims do not seek to recapture subject matter that was surrendered, and thus the statement of error in the original declaration is believed to be accurate and provides a sufficient basis for reissue.

With respect to the inadvertent omission of the required statement regarding no deceptive intent, a supplemental declaration from the inventors incorporating the required statement is enclosed herewith.

The Reissue Claims Are Not Barred by the Recapture Rule

Applicant does not disagree with the statements made in the Office action regarding the fact that the new independent reissue claims (i.e., claims 39, 57 and 59) define alternative "search regions" within the "identifying" step of claim 1 of the '300 Patent. Applicant also acknowledges that this "identifying" step, which originally defined the search region as "a table of contiguous data-containing cells encompassing said active cell and bordered by empty cells," was added to overcome a prior art rejection. However, Applicant respectfully disagrees with the contention that the new reissue claims (which simply recite alternative search regions) are attempting to recapture subject matter previously surrendered. As noted in Ball Corp. v. U.S., 221 U.S.P.Q. 289, 295 (Fed. Cir. 1984):

> The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or of broader scope than those claims that were canceled from the original application. On the other hand, the patentee is free to acquire, through reissue, claims that are narrower in scope than the canceled claims. If the reissue claims are narrower than the canceled claims, yet broader than the original patent claims, reissue must be sought within 2 years after grant of the original patent.

Thus, the determination that must be made in this instance is whether the reissue claims are of the same or broader scope than the claims of the original application. The statement in the Office action notes that the reissue claims are broader than claim 1 of the issued '300 patent. However, as noted above, this is not the test for recapture and has no bearing on the present reissue application since this broadening reissue was filed within two years from the issue date of the original patent. Thus, the recapture rule simply prohibits an applicant from recapturing the **original scope** of a canceled claim by noting that the inadvertent cancellation of such a claim (such as by amending the claim) does not constitute a proper error for a reissue application. See also, 4 Chisum on Patents, § 15.03[2][e] at 74-75:

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Under the "recapture" doctrine, the deliberate surrender of a claim to certain subject matter during the original prosecution of the application for a patent is not such "error" as will allow the patentee to obtain or "recapture" that subject matter in a reissue. However, a patentee may obtain on reissue a claim that varies materially from the claim originally surrendered even though it omits a limitation intentionally added to obtain issuance of the patent.

This is precisely the circumstance of the present reissue application. While the above-described amendment in the original application may be deemed as surrendering the scope of original claim 1 of the application, Applicant is not attempting through the present reissue claims to recapture the scope of that original claim. That is, the reissue claims are not "the same as or broader than" claim 1 of the original application. Rather, claim 1 of the original application only required as "association" between active cell and the cells containing the completed data items (i.e., the "search region" in the amended claim). For the Examiner's convenience, claim 1 of the original application is included below in its entirety:

> 1.   A method for completing a data entry for an active cell of a spreadsheet having a plurality of cells arranged in a grid of rows and columns, comprising the steps of:
>
> > generating a list of completed data items from a range of said cells having an association with said active cell;
> >
> > defining a partial data entry within said active cell;
> >
> > searching said list of completed data items to identify a suggested completion comprising said partial data entry; and
> >
> > in response to identifying said suggested completion, displaying said suggested completion within said active cell.

This claim was amended after-final to include a number of additional limitations as found in issued claim 1 of the '300 Patent. Chief among these limitations was the additional step of "identifying a list of completed data items from a search region within said spreadsheet comprising a table of contiguous data-containing cells encompassing said active cell and bordered by white spaces." This limitation was argued as distinguishing the prior art Smith reference. See Amendment B (paper no. 8) which stated in pertinent part:

> The search region, as recited by [amended] claim 1, comprises a table of contiguous data-containing cells encompassing the active cell and bordered by empty cells. The Smith reference does not describe searching a database using an active cell's physical association to other data items

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within the database, but rather, searches the entire database of previously entered data items. As a result, the search region for an active cell has no defined boundary parameters. All previously entered database items are considered to be associated with an active cell.

However, as noted in the Request for Reissue, the above added limitation from the original prosecution represented only one of the specific "defined boundary parameters" disclosed in the specification of the '300 Patent. The present reissue claims (i.e., independent claims 39, 57 and 59) each define alternative "boundary parameters" for the search region consisting of either a column or a row of the spreadsheet containing the active cell. Claim 39 further includes even narrower subsets of cells comprising either a column or row of cells within N cells of the active cell. Thus, it is clear that each of the reissue claims is narrower in scope than original claim 1 (i.e., the "canceled claim") by limiting the search region to a defined boundary that is narrower than "the entire database of previously entered data items."

In sum, it is clear that the reissue claims are narrower in scope than original claim 1 reproduced above. The new reissue claims are narrower in the same manner that the original claims of the '300 patent were narrowed (i.e., by defining a boundary of a search region used to limit the list of completed data items for which suggestions would be provided during the Auto-Complete process). That is, because claim 1 in its original form did not recite any specific search region or boundary for the cells to be searched, the reissue claims are narrower than original claim 1. Thus, according to Ball, the recapture rule simply does not apply in this case. See also MPEP § 1412.02 (specifically the section entitled "Reissue Claims Are Narrower In All Aspects") which cites Ball for the above proposition and notes that the "patentee is free to acquire, through reissue, claims that are narrower in scope in all aspects than claims canceled from the original application."

In light of the above remarks, it is clear that the recapture rule does not apply to the pending claims and reconsideration is respectfully requested of the rejection of claims 1-60 based on the purportedly defective declaration. Indeed, the current statement of error is believed to be accurate and to provide a proper basis for reissue. The error noted in the declaration was further explained in the preliminary amendment accompanying the reissue application. Specifically, the alleged error is that the search region recited in the amendment to original claim

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1 (i.e., a table of contiguous data-containing cells surrounded by blank cells) was more restrictive than necessary to overcome the outstanding claim rejections and that the prosecuting attorney failed to appreciate that other search region definitions disclosed in the '300 patent would also distinguish the cited references. In light of this error, the full scope of the invention is not believed to be claimed in the '300 patent and the present reissue claims attempt to correct this error by adding new claims to specifically recite the alternative search regions described in the specification. These new claims are believed to be of a similar scope to the allowed claims and are narrower in scope than the canceled (original) claim 1.

Prior Art Rejections of Claims 39-46, 50-54 and 56-60

The rejection of the newly added independent claims, as well as certain of the dependent claims, appears to be similar to rejections noted in the first Office action of the parent application. In the present case, the rejection over Smith, Novell and Sullivan appears to be predicated on the assertion that Smith searches the entire database for previous entries (see above discussion regarding recapture) and thus Smith covers the case where "N equals zero" in the newly added claims.

Initially, it is noted that independent claims 57 and 59 do not limit their respective column or row search regions to a range of N cells from the active cell. Rather, these limitations are found in dependent claims 58 and 60, respectively. Secondly, it is not understood how Smith, which purportedly discloses searching an entire database, discloses the special case where N equals zero. Thus, Applicant respectfully traverses this rejection. However, in the interests of clarity, Applicant has amended each of the claims limiting the search region to N cells from the active cell to require that N be an integer greater than zero. This change is made to make the claims more definite since it is believed that the case where N equals zero would not provide for any suggested data items (i.e., a search region zero cells from the active cell would comprise an empty search region).

In light of the amendments to claims 39, 58 and 60 to add the requirement that N be greater than zero, it is believed that these claims overcome the Examiner's rejections (to the extent that those rejections are understood). With respect to the disclosure of the three cited

references themselves, it is clear that none of these references (alone or in combination) describe identifying a list of completed data items from a search region within a spreadsheet as recited in the new claims. Furthermore, none of the references discloses or suggests the specific search regions recited in the new independent claims 39, 57 and 59.

With respect to the Smith reference, Smith does not describe the present invention but rather searches the entire database of previously entered data items. As a result, the search region for an active cell has no defined boundary parameters and all previously entered data items are considered to be associated with the active cell. The Novell (Quattro Pro) reference does not cure the omission of Smith since Novell does not describe the use of any search region to fill blank cells. Rather, Novell describes filling a plurality of blank cells with a <u>predefined</u> series. Additionally, the Sullivan reference fails to describe or suggest identifying a list of completed data items based on the position or association of an active spreadsheet cell to those items. Thus, to the extent that the combination of references can be said to search an <u>entire</u> <u>database</u> for previous entries (as alleged in the Office action), these references still do not disclose or suggest a more limited search region as described in both the original claims (1-38) of the '300 Patent or the new claims of the reissue application.

As described above, the specification of the '300 Patent describes a number of potential restrictions to the search region used to define suggestions for the AutoComplete function, and the prior prosecution of the '300 Patent added one of the disclosed restrictions or boundaries in an after-final amendment (e.g., a table of contiguous, data-containing cells bordered by empty cells). However, the prosecuting attorney failed to recite any of the alternative search region boundaries defined in the specification (see column 12, line 36 of the '300 Patent). Indeed, this failure constitutes the error upon which the present reissue application is based. As noted in new claim 39 above, the alternative search region boundaries include cells sharing the same row or column as the active cell, as well as cells sharing the same row or column as the active cell and within a range of N cells from the active cell, where N is an integer greater than zero. These alternative search region boundaries represent a narrowing limitation to the original scope of claim 1 (so that the recapture rule does not apply as discussed above), and further define an invention that is neither shown nor suggested by any of the cited prior art references. Thus,

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independent claims 39, 57 and 59 are believed to be allowable over the cited references for the same reason that the independent claims of the '300 Patent were found to be allowable.

Specifically, the cited references do not disclose or suggest an AutoComplete function where the suggested completions are limited to one of the search regions recited in the present claims. Indeed, the prior art actually teaches away from the present invention by teaching that one should look to the entire contents of the database for suggested entries. New claims 39-60 (like original claims 1-38) distinguish these "entire database" references by limiting the search region to reduce the number of "false" suggestions. That is, by limiting the search region to those areas directly related to the active cell (e.g., the same row or column), the invention recited in the pending claims will be less likely to burden a spreadsheet user with unwanted or incorrect suggestions. In light of the above, reconsideration of the § 103 rejections of claims 39, 57 and 59 is respectfully requested.

The pending dependent claims 40-46, 50-54 and 56-60 are also believed to be allowable in conjunction with their respective independent claims, and for the additional reason that each of the dependent claims recite a further limitation that is not shown by the combination of the three recited references. See, e.g., the Remarks section of Amendment A (paper no. 6) of the '300 Patent which addresses each of the same dependent claim rejections found in the present Office action. Thus, reconsideration of the § 103 rejections of claims 40-46, 50-54 and 56-60 is respectfully requested.

It is noted that there were no prior art rejections of dependent claims 47-49 or 55 and thus these claims are believed to be allowable in light of the above comments regarding recapture and the submission of the supplemental reissue declaration.
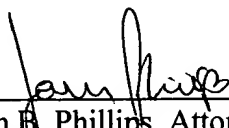
Conclusion

This amendment is believed to be fully responsive to all points in the Office action. New claims 39-60 are believed to clearly patentably distinguish over the cited art taken alone and in combination. Furthermore, the recapture rule does not apply to the pending claims for the simple reason that these claims are narrower than the "canceled" claims. The application is thus believed to be in condition for allowance and such action is respectfully requested. Should the

Examiner have any remaining issues or concerns, he is urged to contact the undersigned by telephone at (303) 357- 1634 to address those concerns.

Dated: February 6, 2002

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Comer, et al.	Examiner:	Feild, J.
Serial No.:	09/728,000	Group Art Unit:	2176
Filed:	December 1, 2000	Docket No.:	MS 39124.2/40062.117-US-RE
Title:	METHOD AND APPARATUS FOR SUGGESTING COMPLETIONS FOR A PARTIALLY ENTERED DATA ITEM BASED ON PREVIOUSLY-ENTERED, ASSOCIATED DATA ITEMS		

CLAIM AMENDMENTS - MARKUP

39.   (Amended) A method for completing a partial data entry for an active cell of a spreadsheet having a plurality of cells defining a grid of rows and columns, the method comprising:

invoking an edit mode for the active cell;

5   identifying a list of completed data items from a search region within the spreadsheet, said search region including one of (1) cells sharing the same column as the active cell, (2) cells sharing the same row as the active cell, (3) cells within the same column as the active cell and within a range of N cells from the active cell, wherein N is an integer greater than zero, and (4) cells within the same row as the active cell and

10   within a range of N cells from the active cell, wherein N is an integer greater than zero;

defining a partial data entry within the active cell;

identifying a matching completed data item from within said list of completed data items that corresponds to said partial data entry;

displaying said matching completed data item as a suggested completion

15   command for said partial data entry;

receiving an acceptance command in association with said suggested completion; and

in response to said acceptance command, storing said partial data entry with said suggested completion within the active cell.

58.   (Amended) The method of claim 57, wherein said search region is further limited to a range of N cells from the active cell, wherein N is an integer <u>greater than zero</u>.

60.   (Twice Amended) The method of claim 59, wherein said search region is further limited to a range of N cells from the active cell, wherein N is an integer <u>greater than zero</u>.